

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

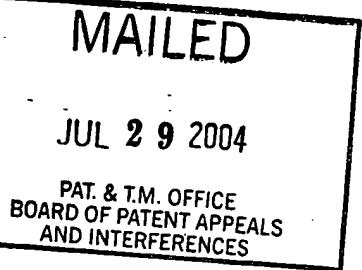
**Ex parte** MICHAEL B. ROBIN

Appeal No. 2003-0975  
Application No. 09/052,278

ON BRIEF

Before SMITH, RUGGIERO, and MACDONALD, **Administrative Judges.**

MACDONALD, **Administrative Patent Judge.**



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**REMAND TO THE EXAMINER**

We remand this application to the Examiner for consideration of the following matter.

**I. The Dates The Examiner Accorded The Present Application And The Applied Prior Art When Formulating The Rejection Under 35 U.S.C. § 103.**

In the final rejection<sup>1</sup> the Examiner rejected claims 1, 3, and 5-8 of the present application filed **March 30, 1998**, under 35 U.S.C. § 103 as being obvious over McLaughlin et al, U.S. Patent No. 5,570,108, filed **October 29, 1996**.

<sup>1</sup> Paper Number 18.

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We note that McLaughlin et al, U.S. Patent No. 5,570,108, claims continuity to U.S. Patent No. 5,499,040 filed June 27, 1994. As discussed in MPEP § 2136.03, under certain conditions one can carry back the 35 U.S.C. § 102(e) critical date of the U.S. Patent reference to the filing date of a parent application. Such conditions appear to be present in the instant situation. Thus, **June 27, 1994** is the critical date of the McLaughlin et al patent.

However, the present application claims continuity to U.S. Patent No. 5,808,604, filed March 10, 1994. As discussed in MPEP § 706.02, the effective filing date of a U.S. application may be determined as follows:

(A) If the application is a continuation or divisional of one or more earlier U.S. applications or international applications and if the requirements of 35 U.S.C. § 120 and 365(c), respectively, have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications.

Thus, **March 10, 1994** is the effective filing date of the present application.

The record before us does not mention nor address in any way the above 1994 dates. Therefore, we request that the Examiner clarify the record and explain why McLaughlin et al, U.S. Patent No. 5,570,108 is available as prior art to the present application.

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Accordingly, we *remand* for consideration of this issue.

***Conclusion***

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the Board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the Board following reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

This application, by virtue of its Special status, requires ***immediate*** action by the examiner. See MPEP § 708.01(d). The Board of Patent Appeals and Interferences ***must*** be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***REMAND TO THE EXAMINER***

*Jerry Smith*

JERRY SMITH )  
Administrative Patent Judge )  
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JOSEPH F. RUGGIERO ) BOARD OF PATENT  
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